Amendments to the Drawings:

The attached sheet of drawings includes changes to Figure 2. This sheet, which includes Fig. 2, replaces the original sheet including Fig. 2.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

Claims 29-82 are pending in the application. In the Office action mailed November 17, 2005, the drawings were objected to, the claims were rejected for obviousness-type double patenting, and the claims were rejected variously under 35 U.S.C. §102(e) or 35 U.S.C. §103(a). The Examiner is thanked for attention to the application.

The drawings and specification are amended as discussed below. The specification has also been amended to properly specify the priority claim. The priority claim was previously acknowledged by the Office, as shown in the filing receipt for the application, which indicates that "This application is a CIP of 08/975,374 11/20/1997 PAT 6,286,140." A copy of the filing receipt is attached herewith. In addition, claims 29, 49, 50, 51, 67 have been amended with a slight wording change which is not believed to vary the scope of the claims.

The drawings are objected to because reference character 27 in Figure 2 has been used to designate both item XMTR (to television) and item CPU. Conversely, the drawings are objected to as the specification refers to CPU 21, which does not appear in the figures. Accordingly, Figure 2 is amended to indicate reference character 21 with respect to the item CPU.

The drawings are also objected to because the specification indicates a polling signal transmitter 32 while the figures show a polling signal transceiver 31. Accordingly, the specification is now amended to indicate polling signal transmitter 31, in conformance with the figures.

The drawings are also objected to as not including the reference signs 33E, 33F, and 33G referenced in the specification. Figure 2 is now amended to include items 33E, 33F and 33G, in conformance with the specification, and to otherwise conform to the informal drawings originally filed with the application.

The claims are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over various claims of U.S. Patent No. 6,286,140, either alone or in conjunction with other art. As an initial matter, the form language in the Office action discusses a statutory-type double patenting rejection. Office action, p. 4. The discussion for the various claims in the Office action, however, refers to obviousness-type double patenting. Also,

the discussion in the Office action for specific claims indicates that any conflicting claims are merely not patentably distinct from each other, and therefore not identical as required for a statutory-type double patenting rejection. Accordingly, it appears that form language for an obviousness-type double patenting rejection was intended.

An obviousness-type double patenting rejection can be overcome by the filing of a terminal disclaimer. However, as the claims are also rejected under 35 U.S.C. §102 or 35 U.S.C. §103, a terminal disclaimer at this stage of the proceedings is premature. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be held in abeyance until Applicant is provided an indication of allowable subject matter.

It is also noted that the Office action, in discussing the obviousness-type double patent rejections indicates that Official Notice is taken that "it is notoriously well known in the art for a feature to be disabled" and that "from claims 1+3 in the patent all the listed claims are clearly obvious variations of different types of input devices and means for monitoring the input devices." Office p. 10 and 12. It is not clear from the context of the Office action whether Official Notice is proper or appropriate for the above, and clarification of the matter for which Official Notice is taken, and documentary evidence for the same, is respectfully requested.

Claims 29, 49, 50, 51, and 67 are the independent claims in the application. Claims 29, 50, 51, and 67 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,177,931 to Alexander et al. Claim 49 is rejected under 35 U.S.C. §103(a) as being unpatentable over Alexander et al. in view of U.S. Patent No. 6,275,991 to Erlin.

Claim 29 specifies "An integral unit for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program an advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal." The Office action states that Alexander et al. "fails to teach wherein the programming and advertising content is transmitted to the television with an Internet access signal (Column 8 lines 44-52)." Office action, p. 15.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union*

Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Circ. 1987), cited in MPEP § 2131 under heading "To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim". Accordingly, the rejection of claim 29 under 35 U.S.C. §102(e) is improper.

The Office action also points to col. 8, lines 44-52 of Alexander et al. The specified portion of Alexander et al. discusses that "the viewer's television is connected to the Internet by telephone line via modem...and by other conventional methods of communicating with the Internet...the viewer uses a remote control device to select one of the EPG [electronic program guide] Internet websites...once the connection between the viewer's television system and the Internet is made, the user has two-way communication with the on-line Internet service provider of the EPG related information." Alexander et al., col. 8, lines 45-60. Accordingly, it appears that the cited portion of Alexander relates to obtaining EPG related information, and does not disclose or suggest "an integral unit for measuring viewer behavior related to television content...comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program an advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal" as specified in claim 29.

Accordingly, claim 29 is allowable over Alexander et al., as are dependent claims 30-48. As claim 29 and, with reference to further discussion, claims 49, 50, 51, and 67, are allowable over Alexander et al., there is no need to discuss the effective priority date of the claims as indicated in the Office action.

Is it also noted that the Office action at page 6 indicates that "the Examiner takes official notice that it is notoriously well-known in the art for programming and advertising content to be transmitted to a television via an Internet access signal." Office action, p. 6. "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." MPEP §2144.03.A. "[T]he notice of facts beyond the record which may be taken by the Examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citing In re Knapp Monarch Co., 296 F.2d 230, 132 USPQ 6 (CCPA 1961)."

It does not appear that the subject for which Official Notice is taken is capable of such instant and unquestionable demonstration as to defy dispute. It is respectfully requested that the Examiner provide documentary evidence regarding the subject of the official notice. In addition, even if the subject for which official notice was taken was notoriously well-known in the art, which is disputed, it does not appear clear why such could be combined with the disclosure of Alexander et al. to arrive at the invention as claimed in claim 29.

Accordingly, claim 29 and dependent claims 30-48 are still further allowable in view of Alexander et al.

Claim 49 is rejected under 35 U.S.C. §103(a) as being unpatentable over Alexander et al. in view of Erlin. The Office action refers to the discussion of claim 29 for much of the rejection to the limitations of claim 49. See Office action, p. 23.

Claim 49 specifies "an integral unit for measuring viewer behavior related to television content...the integral unit comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal." As discussed above, the Office action indicates that Alexander "fails to teach wherein the programming and advertising content is transmitted to the television with an Internet access signal." Office action, p. 15. Also as discussed above, it does not appear that Alexander discloses or suggests programming and advertising content transmitted to a television with an Internet access signal. Further, as discussed above, to the extent that official notice is taken that it is notoriously well-known in the art for programming an advertising content to be transmitted to a television via an Internet access signal, at the time of the invention, it is respectfully requested that documentary evidence of the same be provided, and Applicant allowed the opportunity to rebut, for example, any alleged motivation to combine such with, for example, Alexander et al.

Accordingly, claim 49 is allowable in view of Alexander et al.

Claim 50 is rejected under 35 U.S.C. §102(e) in view of Alexander et al. The Office action primarily points to the discussion in the Office action of claim 29 for rejections to the limitations of the claim. Office action, p. 17. Claim 50 specifies "an integral unit for measuring

viewer behavior related to television content...the integral unit comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal."

As discussed above, Alexander et al. does not appear to disclose, for example, programming an advertising content transmitted to a television with an Internet access signal. Also as discussed above, it appears inappropriate to take official notice of such.

Accordingly, claim 50 is allowable in view of Alexander et al.

Claim 51 rejected under 35 U.S.C. §102(e) in view of Alexander et al. The Office action points to the rejection of claim 29 for the rejection of claim 51. Office action, p. 17.

Claim 51 specifies "a set top box for measuring viewer behavior related to television content...the set top box comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal."

As discussed above, Alexander et al. does not disclose or suggest programming and advertising content transmitted to a television with an Internet access signal. In addition, it is inappropriate to take an official notice of such.

Accordingly, claim 51 and dependent claims 52-66 are allowable in view of Alexander et al.

Claim 67 is rejected under 35 U.S.C. §102(e) in view of Alexander et al. In rejecting claim 67, in the Office action points to the rejection of claim 29. Office action, p. 18.

Claim 67 specifies "a cable box for measuring viewer behavior related to television content...the cable box comprising: a monitoring device...monitoring an event data generated upon occurrence of an event to ascertain the responses of a viewer to program and advertising content...wherein the programming and advertising content is transmitted to the television with an Internet access signal." As discussed above, Alexander et al. does not disclose or suggest programming and advertising content transmitted to the television with an Internet access signal. Also as discussed above, it is inappropriate to take official notice as such.

Accordingly, claim 67 and dependent claims 68-82 are allowable in view of Alexander et al.

As the claims are allowable with respect to 35 U.S.C. §102 and 35 U.S.C. §103, an indication of such allowability is respectfully requested.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By _____

Daniel M. Cavanagh
Reg. No. 41,661
626/795-9900

DMC/rmw

RMW IRV1096445.1-*-05/17/06 9:28 AM

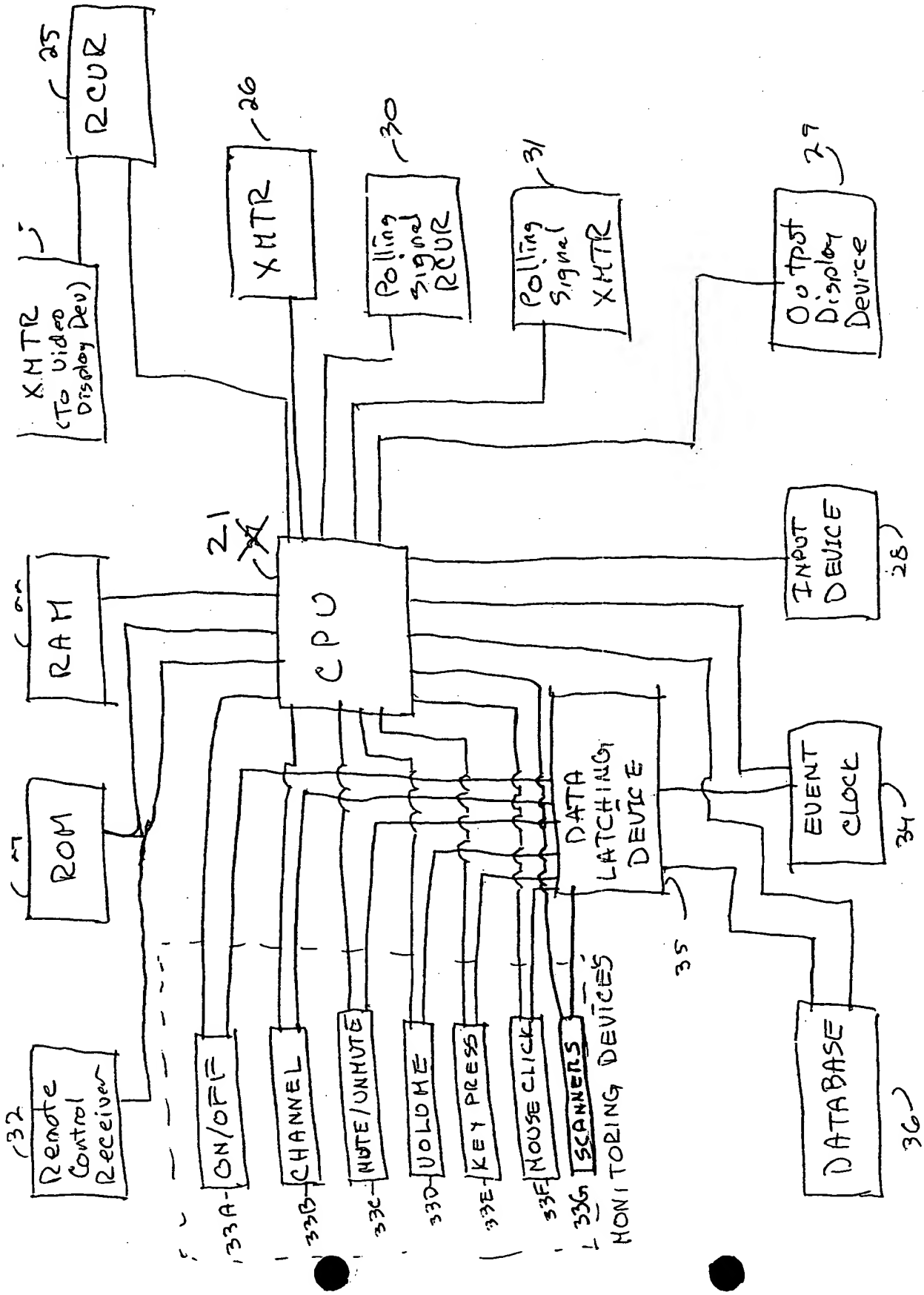

Fig. 2